

Applicant : Reginald Penner, et al.  
Appl. No. : 09/976,990  
Examiner : Arun S. Phasge  
Docket No. : 703538.13

### Remarks/Arguments

Claims 1-19 are pending in this application. Claim 20 has been cancelled without prejudice.

#### I. Affirmation of Election Made Without Traverse Under Restriction Requirement.

In the Office Action, the Examiner issued a restriction requirement under 35 U.S.C. § 121. The Examiner thereby required Applicant to elect to further prosecute Group I claims (claims 1-19) or Group II claim (claim 20) and to affirm a provisional election with traverse to prosecute Group I claims (claims 1-19) made by Kenneth Roberts during a telephone conversation with the Examiner on September 8, 2003. Applicant hereby affirms the election made by Kenneth Roberts and elects to prosecute Group I claims (claims 1-20). Applicant herein has cancelled claim 20 without disclaimer or prejudice to be pursued in this or a later-filed continuation, continuation-in-part, or divisional application.

#### II. Rejections under 35 USC §102

Claims 1, 4-9 and 16-19 are rejected under 35 USC §102, as being anticipated by Zach et al. article entitled "Molybdenum Nanowires by Electrodeposition." The Zach reference was co-written by two of the named inventors of the present application, Michael P. Zach and Reginald M. Penner. As stated in the attached Affidavit of Michael A. Zach and Reginald M. Penner, the third co-author of the Zach reference is not a co-inventor of the subject matter of the pending claims. *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982). Therefore, pursuant to MPEP 715.01(c), the Zach reference has been overcome by a showing that the reference was co-authored by the named inventors of the present application. Accordingly, Applicant respectfully submits that Claims 1, 4-9 and 16-19 are in condition for allowance.

Applicant notes with appreciation the Examiner's conclusion that Claims 10-15 are allowable over the prior art of record and that Claims 2-3 would be allowable if rewritten in independent form.

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III. Conclusion

Prompt and favorable action on the merits of the claims is earnestly solicited. Should the Examiner have any questions or comments, the undersigned can be reached at (949) 567-6700.

The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 15-0665.

Respectfully submitted,

ORRICK, HERRINGTON & SUTCLIFFE LLP

Dated: 12-04-03

By:



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